



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,427	09/08/1999	THEODORE JAMES MYERS	AOO506	8593
757	7590	03/21/2006		
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER BLECK, CAROLYN M	
			ART UNIT 3626	PAPER NUMBER

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,427

Applicant(s)

MYERS ET AL.

Examiner

Carolyn M. Bleck

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15, 17-22, 24, 25, 38-43, 59-63 and 66-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15, 17-22, 24-25, 38-43, 59-63, 66-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed on 14 July 2005. Claims 12-15, 17-22, 24, 25, 38-43, 59-63 and 66-68 are pending. Claim 38 has been amended.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 12-15, 17-22, 24-25, 38-43, 59-63, and 66-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant argues that "auctions based on at least one offer and at least one counteroffer is enabled by the specification and claims." The Examiner disagrees, and the rejection is maintained.

The independent claims are directed to at least auctioning the goods or services to a customer based at least on one offer and at least one counteroffer. Applicant has relied on dictionary definitions of offer, counter-offer and auction. Applicant has defined

Art Unit: 3626

an auction to be “a sale of property to the highest bidder” and a counteroffer to be “a return offer made by one who has rejected an offer.” However, the originally filed specification fails to define the term auction and counteroffer, and further does not contain an enabling disclosure for this feature as claimed and as defined.

Claims 12, 20, and 38 all claim a feature of negotiating with the reservation communication device or via a first communication interface for the good or service responsive to the auctioning of the good or the service to the customer, wherein the auctioning allows for at least one offer and at least one counteroffer. The Examiner respectfully submits that there is no disclosure of how the reservation communication device is able to auction the service or good to the highest bidder. There is no disclosure of how the reservation communication device utilizes the offers and counteroffers and whether the reservation communication device actually makes counteroffers or offers. How does the reservation communication device determine which customer receives a good or service that is auctioned, where there is an offer and counteroffer and also multiple customers? For example, suppose Customer1 submits an offer, the reservation communication device submits a counteroffer to Customer1, and then Customer2 submits an offer. How would the reservation communication device know which offer to accept or whether to make a counteroffer to Customer2? Because Applicant fails to describe how the reservation communication device is able to auction a good or service using offers and counteroffers, the specification does not contain an enabling disclosure. Based on Applicant's disclosure it appears that this feature is a form of negotiating between two devices for a good or service, where there

Art Unit: 3626

are offers and counteroffers. There does not appear to be an indication that the reservation communication device offers the good or service to the highest bidder.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12, 13, 18-21, and 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeitman, Pat. No. 5,940,481 in view of Yoshida, Pat. No. 5,877,704 and Walker et al., Pat. No. 5,794,207 (hereinafter Walker).

(A) Claims 12, 13, 18-21, and 39-42 have not been amended and are rejected for the same reasons given in the prior Office Action (mailed 24 February 2005). The amendments to claim 38 appear to have been made to add a limitation present in claim 12. The Examiner had already addressed this limitation in the rejection of claims 12, 20, and 38 in the Office Action mailed 24 February 2005. Thus, claim 38 is rejected for the same reasons given in the prior Office Action (mailed 24 February 2005), and incorporated herein.

Art Unit: 3626

6. Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeitman, Yoshida and Walker as applied to claims 12 and 20 above, and further in view of Sehr, Pat. No. 6,085,976.

(A) Claims 15 and 22 have not been amended and are rejected for the same reasons given in the prior Office Action (mailed 24 February 2005).

7. Claims 43 and 59-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeitman, Yoshida and Walker as applied to claims 12, 20, and 38 above, and further in view of DeLorme et al., Pat. No. 5,948,040 (hereinafter DeLorme).

(A) Claims 43 and 59-63 have not been amended and are rejected for the same reasons given in the prior Office Action (mailed 24 February 2005).

8. Claims 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeitman, Yoshida, and Walker and DeLorme in view of Examiner's use of official notice. Claims 2, 4-8, 10, 12-15, 17, and 20-21 have not been amended and are rejected for the same reasons given in the prior Office Action (paper number 4; section 3(A)-3(L); pages 2-9).

(A) Claims 67-68 have not been amended and are rejected for the same reasons given in the prior Office Action (mailed 24 February 2005).

Response to Arguments

9. Applicant's arguments filed on 14 July 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed on 14 July 2005.

(A) At pages 12-15 of the response filed 14 July 2005, Applicant argues that the applied references fail to teach "auctioning the good or service" to the customer.

In response, the Examiner respectfully submits that Walker discloses "auctioning the good or service to the customer. Walker discloses allowing a buyer to make an offer (CPO) and allowing a seller to make a counteroffer (col. 8 lines 42-56, col. 9 lines 44-50). Walker discloses allowing a buyer to set conditions for the offer such as indicating for the twenty four hours following the first attempt to bind a CPO (i.e., seller accepting an offer), other sellers may make offers to bind, with the original binding seller completing the contract only if no better offer has been received (col. 16 lines 37-45). It appears that this is a form of "auctioning the goods or services to a customer based at least on one offer and at least one counteroffer."

It is noted that Examiner has given the broadest reasonable interpretation to the word "auction." There are many different types of auctions including Dutch auctions, English auctions, and reverse auctions. For example, a reverse auction is defined as a type of auction in which the role of the buyer and seller are reversed with the primary objective to drive purchase prices downward, where sellers compete for the right to

provide a good. (See http://en.wikipedia.org/wiki/Main_Page, "reverse auction").

Applicant has failed to provide a specific definition within the specification of the term auction, and thus Examiner has given this term the broadest reasonable interpretation.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

Art Unit: 3626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

Application/Control Number: 09/391,427

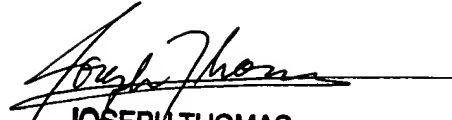
Page 9

Art Unit: 3626

AS

CB

March 16, 2006

A handwritten signature in black ink, appearing to read "Joseph Thomas", written over a horizontal line.

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER